Remarks

The present paper is in response to the Advisory Action dated March 30, 2007, where the Examiner maintained the rejection of claims 17 – 30. In the present paper, claims 17, 23, and 29 have been amended and new claim 31 has been added. Accordingly, claims 17 – 31 are pending in the present application with claim 17 being the independent claim. Reconsideration and allowance of pending claims 17 – 31 in view of the following remarks are respectfully requested.

35 USC §103(a)

In the Advisory Action, pending claims 17 – 30 stand rejected under 35 U.S.C. 103(a) as obvious with respect to U.S. Patent No. 6,684,369 ("Bernardo") in view of U.S. Publication No. 2002/0059325 ("Beizer"). The Advisory Action asserts that it would have been obvious to one of ordinary skill in the art to combine Bernardo with Beizer to provide a data environment where all documents, supporting data, and history related to a unit of work are grouped together. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

A. Suggestion or Motivation to Combine

In the Office Action, the cited motivation is "*to provide a data environment where all documents, supporting data, and history related to a unit of work are grouped together.*" However, this is not the object of the invention and provides no motivation for one skilled in the art to combine the references to arrive at the claimed invention. Specifically, the claimed invention is directed toward a method of generating a document, not a method for grouping related documents together. Furthermore, contrary to the cited motivation the claimed invention requires that a document

template and content data are received and combined to generate a document. The document is modified by looking into the document, locating the uniform resource locators (URLs) in the document and replacing the URLs with new URLs. Depending on the context of how the user is publishing or using the document, different URLs can be inserted to make the document work in its new location.

For example, "the web page module 114 determines the context 502 in which the web page will appear. There are four contexts: template preview, stage preview, local stage or publish, and external stage or publish." (See, Page 35, Paragraph 0122). Therefore, depending on how the user is using the web page, a different URL is needed in the web page to make it work at its current location.

This effectively decouples related documents as the modified document is published to a new location while the generated document is not. Accordingly, the cited motivation to combine the references fails to rise to the level necessary to make a *prima facie* case of obviousness because the motivation would cause one skilled in the art to make a combination that performed an entirely different function than what is claimed.

Applicant respectfully submits that the cited prior art is only combined in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicant's own invention characterization, not a properly motivated combination of Bernardo and Bezier. Specifically, the combination of references made in the §103(a) rejection are not based upon a true nexus of related ideas in the same field of art with a demonstrated motivation to arrive at the claimed invention.

"Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue….To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that would create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-

5

1458 (Fed. Cir. 1998). "The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Here, no such desirability has been shown to exist in the prior art.

B. Reasonable Expectation of Success

The second prong of the obviousness analysis requires that the Office Action demonstrate that the combination of the cited prior art references points to the reasonable expectation of success in the present invention. The Office Action fails to meet this burden because neither of the references suggest that the document is modified based on the new URL.

See Figure 10 of Biezer, for example. Figure 10 shows a history data element. As Figure 10 shows, a change log can be used to determine who made changes to documents and what the changes were. Figure 10 is similar to a log of a "save as" function as it can show an old and new location of a document. It cannot, however, go into a document and change URLs based on the context of how a document is being used.

For example, under the Bernardo-Biezer combination, Figure 10 can be used to show that a document was moved from a first location to a second location. However, having the change log in Figure 10 in no way enables the Bernardo-Biezer combination to go inside a document and substitute URLs based on context as is presently claimed. In fact, the document in Figure 10 is not "the document" as presently claimed. The document in Figure 10 of Biezer is a separate change log document. Thus, entries in the change log document of Biezer in no way make the combination likely to succeed with respect to the document being currently edited.

Accordingly, documents modified and published to a new location under the Bernardo – Bezier combination would fail to operate in the new location because the internal URLs (of the modified and published document) would not be changed, and hence would not work in the new location. Accordingly, the Office Action fails to make a *prima facie* case of obviousness because it does not demonstrate that a reasonable expectation of success exists. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

C. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claimed invention. Bernardo teaches a system for creating documents from templates and content that are combined into the document that is created. Bernardo goes no further, as acknowledged by the Office Action on page 4.

The Office Action then cites Bezier as teaching the following elements:

(i) identifying a current location of the document;

(ii) identifying a new location for the document;

(iii) modifying the document based on the new location to generate a modified document; and

(iv) publishing the document to the new location.

The passage in Bezier (¶ 67) that is cited as teaching each of these elements is set forth in full below:

> The WFX WorkFolder program can also be used to view and edit WorkFolder-based Microsoft Exchange forms directly, in the absence of any WorkFolder message. This is referred to as Template Editing Mode. Rather than loading a WorkFolder message through the mechanism described above, the WFX WorkFolder program makes Microsoft Exchange Software function calls to load a user-specified WorkFolder-based form directly for editing. **Once loaded, the save and publish functions available in the WFX program will republish the form to the same or a different location in the Microsoft Exchange forms subsystem**, also through the use of Microsoft Exchange Software function calls.

Although not specified in the Office Action, Applicant believes that the portion emphasized in bold is what is being relied upon as teaching the steps recited above that are not taught by Bernardo. It appears that the assertion is that because the WFX program can republish the form to the same or a different location that the steps for (i) identifying a current location of the document; and (ii) identifying a new location for the document are disclosed by Bezier. Furthermore, because the WFX program can republish the form to a new location that the step for (iv) publishing the document to the new location is met.

Applicant has amended the claims to clarify that the new and old locations refer to URLs. What is not present in the passage is the required step for (iii) modifying the document based on the new URL to generate a modified document. While the cited passage does say that the form is loaded for editing, it goes no further. Importantly, the claimed invention is a computer implemented

method and requires that the document be edited based on the new URL to generate a modified document.

First, Figure 10 in Biezer shows a change log that can indicate changes to documents. One example in Figure 10 includes adding a new URL. However, the change log generated in Biezer is not the same document as the document being modified and published. Unlike Biezer, the present claims automatically change URLs in the same document that the user is editing and publishing. The URLs within the document are changed based on context, for example, based on the type of server they are being published to, so that they work on the server. Figure 10 is a separate document in Biezer, so in the Biezer-Bernardo combination, in light of Figure 10 of Biezer, nowhere is it taught that URLs are automatically changed within the same document, before it is posted.

Second, nowhere does Bezier suggest that the Template Editing Mode processes a document and modifies that document based on a new URL. To the contrary, Bezier teaches that the form is loaded for editing – by a user – and then the form can be saved or published in the same or a new location. This is an important distinction because the modifying of the document based on the new URL is what allows the content data in the document to function correctly once it is published to a new location. Bezier's Template Editing Mode does not recognize this problem nor teach this particular required step of the claimed invention. Accordingly, the Office Action fails to establish a *prima facie* case of obviousness because the combination of references does not teach all of the limitations in independent claim 17 and its respective dependent claims. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

D. New Claim 31

New claim 31 adds an additional limitation to independent claim 17, which is "determining whether the document needs to be modified based on a context of the URL." New claim 31 adds an additional limitation that is not found in the Biezer-Bernardo combination. New claim 31 covers the case where the present invention looks into the merged document, finds the URLs, and determines whether the URLs need to be changed based on the context. For example, there are four contexts: template preview, stage preview, local stage or publish, and external stage or publish." (See, Page 35, Paragraph 0122).

8

Depending on the context, the document may be published to different servers and viewed through different user interfaces. To make these pages work in all contexts, part of the replacement of internal URLs includes determining whether the URLs need to be replaced to make the document work in the new context.

The Biezer-Bernardo combination does not change URLs automatically within a document based on context. Figure 10 of Biezer, in fact, is a wholly different document than the web page. For at least that reason, merely recording changes to a separate document in a change log is not associated with changing URLs within the same document being edited and published. For at least that additional reason, applicant requests that a notice of allowance be issued with respect to new claim 31.

E. Summary

In summary, the Office Action does not provide proper motivation to combine the teachings of Bezier with Bernardo. Further, the Office Action does not demonstrate that the modification of the cited prior art reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. Finally, the combination of Bernardo and Bezier lack each of the steps of independent claim 17 and thus fail to establish a *prima facie* case of obviousness. Accordingly, Applicant requests that the §103(a) rejection be withdrawn.

Conclusion

If the Examiner has any questions or comments regarding the above Remarks, or believes that a telephone conversation may be useful in advancing prosecution, the Examiner is invited to contact the undersigned at the number listed below.

Respectfully submitted,
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